

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Susan M. Duncan

Attorney Docket No. ADAP-1-1002

Serial No.: 09/881,856

Group Art Unit: 2859

Filing Date: June 13, 2001

Examiner: Reis, Travis M.

Title: SPACE CONFIGURATION DESIGN TOOL

REPLY BRIEF

Seattle, Washington

February 18, 2007

REPLY

The Examiner's Answer to the Applicant's Amended Appeal Brief offers little in the way of justification for the claim rejections beyond that set forth during the underlying prosecution, and fails to offer more than conclusory statements in response to the Applicant's specific and detailed arguments demonstrating that the claims are entitled to allowance.

Groups I, II & III: The Examiner fails to address the fact that one or more claim limitations are missing from the prior art references upon which the 35 U.S.C. § 103(a) rejections are based, and does not provide an alternative basis for combining the cited reference in a way that would produce the missing claim limitation. Moreover, the Examiner fails to provide any teaching or motivation for combining the two-dimensional template of Bobrick with the three-dimensional figure of Marshall, or of further combining a wand limitation from Stansbury. A showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular. . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence." *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.").

Group IV: The Examiner fails to demonstrate that the cited prior art teaches the specific methodology of claims 35-38. There is simply no basis for combining static positioning disclosed by Marshall with the two-dimensional overlay of Bobrick to produce the claimed invention. Any motion attributable to Marshall is incompatible with movement of Bobrick in the manner claimed, namely:

manipulating the tool within the spaces of a known scale of the design plan to
visually illustrate the feasibility of movement within the spaces of a known scale
in light of the size of the represented support device; and

determining the size of the open spaces of a known scale of the design plan necessary to allow movement of the support device used by persons with disabilities and the aging population based on evaluating the visual illustration of the feasibility of movement within the spaces of a known scale in light of the size of the represented support device.

The Examiner fails to provide a credible basis for ignoring the compelling evidence of secondary considerations submitted in the declarations of Duncan, Hartje, Miller, Tenenbaum and Pace. The Examiner urges that “while declarations are given consideration, [they] alone are not sufficient evidence [of nonobviousness].” Moreover, that such sworn testimony does not constitute “objective” evidence. But the Examiner utterly fails to provide any recognizable basis for this legal conclusion which, as a matter of law, is simply incorrect.

The Courts and this Board have long considered sworn testimony to constitute evidence of a sufficient nature to demonstrate secondary considerations such as commercial success, long-felt need and failure of others. Indeed, the testimony submitted constitute the very best “objective” evidence, as the declarations contain the opinions of experts in the industry establishing the commercial success, long-felt need and failure of others as related to Applicant’s invention. Contrary to the Examiner’s argument, these declarations specifically provide objective evidence of the date that the need arose, the date of the articulation of the problem, that the problem was a persistent need in the industry, that prior attempts in the industry by others did not satisfy the need, and that the need was satisfied by the Applicant’s claimed invention.

For the foregoing reasons, the Examiner’s final rejections should be reversed and the pending claims should be allowed.

RESPECTFULLY SUBMITTED this 18th day of February, 2007.

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ADAP-1-1002REPLYBRIEF

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